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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Robert Salinas
Appl. No.: **10/733,551**
Title: Product Promotion and
Sales in Computer Games,
Simulations, and the like

Via Express Mail: EH161297585US

June 27, 2008

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Examiner: James W. Myhre
Art Unit: 3622

Re: REPLY TO OFFICE ACTION

Dear Examiner Myhre:

1. In response to the Examiner's office action mailed 12/27/2007, having a shortened period for response set to expire 03/27/2008 and an extended period for response set to expire 06/27/2008, Applicant Robert Salinas respectfully submits the following responses in the order set forth in the office action in regard to the above-identified patent application:

Election / Restrictions

2-5. Applicant hereby elects the invention Group II pursuant to the requirements of 35 U.S.C. 121 as follows:

- II. Claims 13-31 drawn to presenting an advertisement in a game in which the user's interaction with the advertisement modifies one or more parameters of the game.

Consistent with Applicant's election made herein, Applicant's response is directed only to claims 13-31. In addition, the undersigned has amended the claims a first time as follows:

Amendment A

In accordance with 37 C.F.R. 1.121, please cancel claims 1-12 and amend claims 13-31 without disclaimer to their content and without prejudice to their subsequent reintroduction into this or a future patent application. In accordance with 1.121(c), a complete claim listing commences on the following sheet (page 7) that identified the canceled claims and lists the text of the new claims.

Double Patenting

6. Applicant has amended the claim 25 which Examiner advised would be subject to an objection under 37 CFR 1.75. In the amended claims, Applicant has taken care to avoid reciting any claim being a substantial duplicate of another claim.

Claim Objections

7. Applicant has amended the claims which Examiner has objected to under 37 CFR 1.75(c). In the amended claims, Applicant has taken care to rewrite claims in proper dependent or independent form.

Claim Rejections - 35 USC §101

8. Applicant has amended claims 23 and 24 which Examiner has rejected under 35 U.S.C. 101 on the ground that the claim is directed to non-statutory subject matter. In the amended claims, Applicant has taken care to recite claims that are directed to

permissible subject matter. Accordingly, this ground for rejection is rendered moot.

Claim Rejections – 35 USC §102

9-10. Examiner relies on a single prior art reference, namely Koenig (7,054,831), in the review of Applicant's claims. Although the cited reference is relevant, it does not disclose the invention claimed by applicant.

Koenig states on page 3:

A key feature of the combined game and infomercial is the requirement that the players research and learn about the various products offered by the vendors 28. As the player 30 maneuvers through the video or animation, they will eventually come to a decision point at which they must decide whether to access an infomercial or other information about a product or service in the content server 26 so that the player and/or participant can research the product to identify or locate clues to facilitate continued play of the game. In this manner, the player can actually score points or product discounts by researching and learning about the products.

Thus, Koenig teaches that an infomercial is presented at a decision point **during** game play and that a player gains ability to play by researching the product and learning knowledge about the product. Koenig's approach interferes with the flow of a game and would require at least a momentary pause in the game. Moreover, for multiplayer games, this method is impractical because the other players must wait. Moreover, Koenig's discloses a method which is not possible in real-time massively multiplayer games without distracting from game play and lessening the entertainment value.

In the cited reference, Koenig continues:

"...This feature actually comprises a four-step process as illustrated in FIG. 4

of research, knowledge, retention and application. First, a player comes to a decision point in the game that requires that they select a product from a group of products that is suitable for the next task that the player must accomplish to advance in the game. For example, the player may be asked to select an appropriate vehicle to cross a certain type of terrain in an allotted time, using a set quantity of fuel. The player is given several vehicle choices that they must research in order to [determine] not only which vehicle is suitable for the task, but what options the vehicle should have (e.g., engine, transmission, tires, etc.), what speed the vehicle should be driven to avoid running out of gas, etc.

In order to complete the task successfully, the player must then not only research each of the vehicle choices to acquire the requisite knowledge, but they must also retain this knowledge and apply it correctly to the task at hand. IF they try to shortcut the process, a likely outcome will be that they will fail to achieve the task by selecting a vehicle that cannot traverse the terrain due to improper tire selection, or by selecting one that runs out of gas due to excessive gas consumption."

Thus, Koenig discloses playing an infomercial which requires an involved process of 4 intermediate steps during the game. In contrast, the Applicant's teaches use of promoted product prior to starting the game or prior to joining the game in play. Further, Applicant claims the invention of a game having a pre-game segment during which the player can select a promoted product with ease and without watching an infomercial. Therefore, Koenig does not anticipate the Applicant's claimed invention.

While other cited prior references disclose in-game advertisements, none of these disclose the product promotion of the type claimed by Applicant. In particular, none of the prior art references teaches a pre-game show disclosed by the Applicant wherein a player simply selects—in mere *seconds*—a branded product in mere seconds without having to watch an annoying infomercial or view a pre-roll

advertisement while a game is loading. Accordingly, the Applicant's invention is an improvement over the prior art and is not anticipated by any of these cited references.

Claim Rejections – 35 USC §103

11-12. Examiner has rejected Claims 14-17, 28 and 29 as being unpatentable over Koenig (7,054,831) for obviousness. The essence of rejection is that modifying an operating parameter has been done before. Applicant claims a method of not only modifying a game parameter but efficiently promoting a product and brand awareness by the players.

About 40 years have passed since the invention of computer games. Some games have included in-game advertisements such as billboards integrated in the game itself. However, the prior discloses inventions using methods of advertising that have extra steps—and thus—are inefficient. Thus, all of the cited prior art distract from play of the game and lessen the entertainment value of the game. In fact, they teach away from the use of a method claimed by Applicant because they require research into a product. Other are not motivated to display advertisements in the way claimed by Applicant because of the brief time—mere seconds—is not suited to traditional advertisements such as infomercials or pre-roll ads that require 10+ seconds.

Applicant's invention overcomes the disadvantages of the prior art in several meaningful ways. First, Applicant's invention overcomes the prior art because the invention teaches a method that is efficient—mere seconds—compared to prior art.

(Figs. 13A-13B). The player needs to simply select the promoted product. Second, the Applicant discloses an invention that includes highlighting of the promoted product using various visual effects (Fig 12A-12C). Third, the Applicant discloses an invention which displays the brand on the product (Fig 15A-15D).

Therefore, for the foregoing reasons, the Applicant's invention is not obvious in view of the prior art.

Remarks/Conclusion

13. The Examiner's office action mailed 12/27/07 and all references cited therein, have been carefully studied by the Applicant. The reply appearing herein is believed to be fully responsive to the Examiner's communication.

Applicant believes that, as amended, claims 13-20 are allowable. If an Examiner's Amendment would place some or all of the pending claims in condition for allowance, please advise by making a telephone call to the undersigned at (760)641-8830. Thank you.

Sincerely,

A handwritten signature in black ink, appearing to read 'Kenyon Potter', is written over a horizontal line.

Kenyon Potter
Reg. No. 50450

Enclosure: Extension Fee (PTO Form 2038)

1-12 (Cancelled).

13. (Currently amended) A computer-implemented method for promotion of products within an electronic game, comprising the steps of:
- receiving at least one input from a player, whereby the player is identified;
- displaying at least one graphical object representing a promoted product wherein the promoted product is brought to the attention of the player by a visual effect and wherein the promoted product has a label or tag that identifies a brand; and
- in response to at least one action being performed by the player, the promoted product is selected by player and the electronic device records the selection in a computer readable medium.
14. (Currently amended) The method of claim 13 wherein the speed of the player is enhanced.
15. (Currently amended) The method of claim 13 wherein the power of the player is enhanced.
16. (Currently amended) The method of claim 13 wherein the dexterity of the player is enhanced.
17. (Currently amended) The method of claim 13 wherein the endurance of the player is enhanced.
18. (Currently amended) The method of claim 13 wherein the method has the additional step of recording the selection by the player at a remote computer in communication with the electronic device via a network.